

BASIS FOR THE AMENDMENTS

Claims 1-17, 20-27 and 29 are active in the present application. Claim 28 has been canceled. Claims 1-17, 26-27 and 29 are currently under active prosecution. Independent Claims 1, 13, 14, 16, 17, 20 and 23 have been amended to include the limitations of previous Claim 28 and now limit the monomer (3) to the non-perfluoroalkylated acrylate or methacrylate monomers recited in the Markush group. Claim 3 has been amended for clarity. No new matter is believed to have been added.

REQUEST FOR RECONSIDERATION

Applicants thank Examiner Rodee for the helpful and courteous discussion of July 21, 2003. Applicants thank the Examiner for indicating in the Office Action of May 19, 2003 that the references provided in the response of March 7, 2003 have been considered. A copy of U.S. patent 6,360,068 is attached herewith (see page 2, lines 1-3 of the Office Action of May 9, 2003).

During the discussion, the Examiner indicated that limiting the monomer (3) to the non-perfluoroalkylated acrylate and methacrylate species of the Markush group in Claim 1 as amended herein may not represent a new issue for consideration and further may overcome the rejection of record. The Examiner further confirmed that the obviousness-type double patenting rejection in view of Claims 1-3 and 45-83 of co-pending U.S. Serial No. 10/114,056 may be held in abeyance until the present application is issued as a patent.

Independent Claims 1, 13, 16, 17, 20 and 23 have been amended to include the limitations of Claim 28. The afore-mentioned independent claims must now contain a monomer (3) selected from the Markush group recited in the claims. Applicants respectfully request entry of the amendment in view of the presentation of this Markush group of monomer species in Claim 28 of the response filed with the Office on March 7, 2003.

The Office has asserted that silicone group-containing monomers such as esters of (meth)acrylic or maleic acids having terminal hydroxyl group-modified silicone oil would be encompassed by the claims as presented in the Amendment and Request for Reconsideration filed with the Office on March 7, 2003. The prior art reference applied by the Examiner, Nakanishi, does not disclose or suggest the acrylate and methacrylate monomers disclosed in the Markush group of previously presented dependent Claim 28 and present amended Claims 1, 13, 14, 16, 17, 20 and 23. Applicants submit the monomers of the amended claims are not obvious in view of the fluorinated or silicone-containing monomers disclosed in Nakanishi.

Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) in view of Nakanishi. Applicants further submit that Claims 5-12, 15, 21-22, 24-25, 26-27 and 29, dependent from amended Claims 1, 13, 14, 16, 17, 21 and 23 are also now in condition for allowance.

Applicants submit the amendment to the claims obviates the rejections under 35 U.S.C. § 112, first paragraph.

On page 5, lines 14-18 of the Office Action of May 19, 2003, it is stated that the specification does not teach using a mixture or combination of acrylate or methacrylate monomers for component (3). Applicants direct the Office's attention to page 13, lines 16-17 and page 16, lines 12-14 and original Claim 1. By referring to acrylate and methacrylate monomers in the plural, the specification encompasses embodiments where more than a single acrylate or a single methacrylate monomer may be present. The "and/or" term in original Claim 1 refers to plural acrylate and methacrylate monomers in both the alternative and conjunctive forms. A plurality of monomers is a mixture or combination of monomers. Therefore, multiple acrylate monomers can make up component (3), multiple methacrylate monomers can make up component (3), or a combination of acrylate and methacrylate monomers can make up component (3).

The Office provisionally rejected Claims 1-17, 26, 28 and 29 under obviousness-type double patenting in view of copending application 10/114,056.<sup>1</sup> As stated in MPEP §804(I)(B):

If the "provisional" double patenting rejection in one application is the only remaining rejection in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent."

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<sup>1</sup> A Office Action was issued on July 14, 2003 in 10/114,056.

Upon determining that the double patenting rejection in the present application is the only remaining rejection in this application, the Examiner is requested to withdraw the rejection per the guidelines provided in the MPEP. If the Examiner determines that a Terminal Disclaimer is still required he is asked to kindly contact Applicants U.S. representative at the telephone number provided at the bottom of the signature page of this response.

Responsive to a Notice from the Office dated April 10, 2003, Applicants re-filed an Information Disclosure Statement originally filed with the Office on June 5, 200<sup>2</sup>~~3~~. *en*  
Applicants respectfully request the Examiner return a signed, dated and initialed copy of the PTO-1449 forms submitted with the IDS with the next communication from the Office. Copies of the PTO-1449 forms, a copy of the letter to the commissioner, and a date stamped filing receipt evidencing their submission on April 29, 2003 are provided for the Examiner's convenience.

In the Response filed on March 7, 2003, Applicants requested the Office return a signed and initialed copy of the PTO-1449 form included with an IDS filed on January 29, 2003. Applicants request that a signed and initialed copy of the form PTO-1449 filed on January 29, 2003 be returned with the next communication from the Office. A copy is attached herewith for the Examiner's convenience.

REQUEST FOR REJOINDER

Claims 20 and 23 have been amended to limit component (3) of the negative charge control agent to those acrylate or methacrylate monomers disclosed in the Markush group presently recited in Claims 20 and 23. As already described above for claims 1, 13-14 and 16-17, none of the prior art references relied upon by the Examiner disclose a negative charge control agent comprising the components recited in Claims 20 and 23. A method of forming an image using the patentably distinct negative charge control agent must therefore also be patentable. Applicants respectfully request the rejoinder and allowance of independent Claims 20 and 23 and Claims 21-22 and 24-25 dependent therefrom.

Applicants submit the amendment to the claims places all now-pending claims in condition for allowance. Applicants respectfully request the withdrawal of the rejections and the passage of all now-pending claims to Issue.

Respectfully submitted,

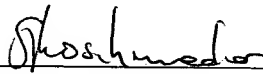
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